

REMARKS/ARGUMENTS

Claims 2-55 are pending in this application and are rejected. Claims 8, 37, and 44 are currently amended, and such amendments are fully supported by the specification and drawings, at least at page 16, lines 6-19. For at least the reasons set forth below, Applicants assert that all claims are in condition for allowance.

Rejection Under 35 U.S.C. § 103

Claims 2-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillingham U.S. 6,327,608, in view of Wolf et al. U.S. 5,818,447. As set forth in more detail below, the references fail to teach or suggest all the claim limitations and there is no suggestion or motivation to modify or combine the references as required by MPEP § 2143. Therefore, the rejection is unsupported by the art, and Applicants respectfully request that the rejection be withdrawn.

(a) *The References Fail to Teach or Suggest a UI Form Definition that Corresponds to a Particular Client Device's Platform or Capabilities*

Claims 8, 20, 37, and 44 recite a UI form definition that corresponds to or is based on a particular client device's platform or capabilities. The rejection asserts that these limitations are taught or suggested by the Dillingham reference. As previously argued in the Amendment dated 3/23/2005, p. 13-14, Applicants respectfully submit that the combination of Dillingham and Wolf fails to teach or suggest these limitations. In the interest of brevity and clarity, the previous arguments are hereby incorporated by reference. Additionally, claims 8, 37, and 44 have been amended to clarify the UI definition as described below.

In summary, Applicants previously argued that the UI server recited in independent claims 8, 20, 37, and 40 stores a UI form definition or identifier corresponding to a client device's platform or capabilities, and the same form definition is also cached at the client device and then populated with content from the UI server, i.e. source data items. In contrast, the Dillingham reference discloses a distinct configuration and operation that does not provide a UI form definition that corresponds to or is based on a particular client device's platform or capabilities. In response to those arguments, Examiner argued:

Dillingham teaches storing a UI form definition or identifier corresponding to a client device's platform or capabilities at column 3, lines 55-67 by citing "The server 22 runs a Web server software program that establishes a Web site on the World Wide Web. The server 22 has a file system that organizes files, such as Web pages and other documents 30, into hierarchical directories. The Web server accepts requests transmitted over the Internet from a client-based browser program...The Web pages are commonly written in HTML and XML are transmitted using conventional network protocols, such as TCP/IP... The client browser renders the Web page into human-perceptible forms".

OA dated 7/1/2005, p. 14. This argument rests on the supposition that the limitation "UI form definition" is anticipated by Dillingham's web pages written in HTML or XML. However, nowhere does the record support that supposition; the references fail to teach or suggest that Dillingham's web pages correspond to or are based on a particular client device's platform or capabilities. Additionally, the amendments to claims 8, 37, and 44 require that the UI form definition is selected from a plurality of UI form definitions corresponding to a plurality of client platforms or client device capabilities, which is clearly not taught or suggested by Dillingham.

Rather, Dillingham describes a typical Web server transmitting the same HTML and XML instructions to clients, regardless of the clients' platform or capabilities. Col. 3, line 62-Col. 4, line 4. Nowhere does Dillingham teach or suggest storing a UI form definition or identifier that corresponds to a particular client device as claimed. Nor does the reference teach or suggest selecting a web page from a plurality of web pages corresponding to a particular client's platform or capabilities as recited in amended claims 8, 37, and 44. The reference describes creating a "custom client-side object to cache," col. 9, lines 11-21, but this object is created in response to a user selection, col. 7, lines 32-36, col. 7, line 66-col. 8, line 13, not client platforms or capabilities.

Additionally, Wolf fails to teach or suggest modifying Dillingham to achieve these limitations. The Wolf reference describes a system and method for editing email messages with a full-featured word processor application that is separate from the email client. The reference specifically describes embedded objects that can be edited when opened and displayed in a separate window with the UI provided by the application program that created the object. Col. 9, lines 28-39; see also col. 9, lines 39-54 (describing native and foreign frames). However, this

description does not teach or suggest a UI server storing and a client caching the same UI form definition corresponding to a client device's platform or capabilities.

Accordingly, Examiner has failed to establish a *prima facie* case of obviousness as defined by MPEP § 2143, and Applicants respectfully request reconsideration and withdrawal of the rejection.

(b) *The References Fail to Teach or Suggest an Offline Action*

Claim 8 recites, "receiving a command from said client device, said command being indicative of an offline action performed by said client device." As previously demonstrated in the Amendment dated 1/29/2004, pp. 10-11, and Amendment dated 3/23/2005, p. 12-13, the cited references fail to teach or suggest this limitation. In the interest of brevity and clarity, the previous arguments are hereby incorporated by reference. In response, Examiner argued:

[T]he Offline Action can be done at a cache memory at the client PC. The action does not need to require a connection to the server. In Dillingham's system, the list of new files (which are obtained from the server) is cached locally. The data is cached on the client, it may be sorted or items may be selected without requiring another round trip to the server (column 8, lines 15-21).

OA dated 7/1/2005, p. 13. Applicants note that this interpretation does not take into account each and every limitation relating to the "offline action." Specifically, in this example Examiner asserts that the system of Dillingham may locally cache data on a client, and then the data items may be sorted or selected "without requiring another round trip to the server." However, the claim does not merely recite "a command being indicative of an offline action being performed by said client device" but rather the claim also recites "said UI server processing said command for execution by said server-based application." (emphasis added). The original rejection asserts that Dillingham teaches both of these limitations relating to offline actions, see OA dated 7/1/2005, p. 3, but the reference clearly does not support teaching of both limitations together.

In Examiner's example, it would be nonsensical for a server to process the offline action for execution by the server-based application if the offline action (i.e., sorting or selecting the data items) was already performed on the client "without requiring another round trip to the server." If the sorting or selection was performed on the client of Dillingham as suggested by

Examiner, it is unclear why the server would then process or execute the same sorting or selection actions. Moreover, there is no suggestion or motivation—nor does Examiner cite any suggestion or motivation—to modify Dillingham to execute a “sort” or “select” action on both the client and the server. Nowhere does the Dillingham reference, nor the other art of record, teach or suggest modifying the Dillingham reference to include this limitation.

Accordingly, Examiner has failed to establish a *prima facie* case of obviousness as defined by MPEP § 2143, and Applicants respectfully request reconsideration and withdrawal of the rejection.

(c) *There is No Suggestion or Motivation to Combine the References*

Even assuming *arguendo* that the cited references can be successfully combined to teach each and every limitation, there is no suggestion or motivation in the record to do so.

Accordingly, a *prima facie* case of obviousness has not been established. *See* MPEP § 2143.01 (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”).

Dillingham describes a system for browsing and administering remote physical file directories. *See* Col. 3, line 46-Col. 4, line 23 (describing remote physical file directory data and files 30 and 40); *see, also*, Fig. 1 and abstract. In contrast, Wolf describes a system for viewing and editing email messages on personal computer 10, in some cases using a native frame. Col. 4, lines 1- 19; Col. 9, lines 39-46. Specifically, Wolf is directed towards editing and viewing an email message where a “mail note allows a separate, full-featured word processing program to display and edit the email message in the view port provided by the mail note” rather than implementing text editing or word processing functionality in the mail note itself. Col. 4, lines 9-13.

There is no suggestion or motivation in the record that one of ordinary skill in the art, when working with the system for administering remote files of Dillingham, would be motivated to modify the existing user interface therein with another interface. *See, e.g.*, Col. 7, lines 20-23 (“The browser dialog 122 resembles the familiar file management UI supported by Windows-brand operating systems.”). It is even less likely that one of ordinary skill in the art would turn

to a system for editing email messages, as in Wolf, in order to use a native client user interface to display server data. The foundation for Dillingham is file browsing and administration that is performed through a web browser receiving remote HTML and XML instructions. One skilled in the art would not attempt to modify such a configuration with a system for editing email messages.

Examiner states that it would have been obvious “to modify the UI form definition taught by Dillingham to include the server-based application of Wolf et al., in order to access to utilize native client user interface features to display data received from a server as taught by Wolf et al.” OA dated 7/12005, p. 4. However, it is unclear what “features” from the email system of Wolf would be included into the existing user interface of Dillingham, nor are these “features” that are supposedly lacking from Dillingham clear from the record.

Even assuming *arguendo* that certain “features” of Wolf may be included in the existing user interface of Dillingham, the rejection only asserts that modifying the user interface of Dillingham with Wolf would have been obvious if one of ordinary skill in the art had “the teachings of Dillingham et al. and Wolf et al. before them...” OA dated 7/1/2005, p. 4. Even if this statement is true, it begs the question of whether one of ordinary skill in the art would have both references before him or her. This reasoning is clearly based on improper hindsight reasoning. Applicants respectfully remind Examiner that, as the Federal Circuit has noted:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed.Cir.1986) (emphasis added).

Without impermissible highlight, there is no support in the record that one of ordinary skill in the art would have both references before him or her simultaneously.


For this additional reason, Examiner has failed to establish a *prima facie* case of obviousness as defined by MPEP § 2143, and Applicants respectfully request reconsideration of the rejection.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP
Customer Number 25763

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By: 
Christopher R. Hilberg, Reg. No. 48,740
(612) 492-6694